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PTO/SB/21 (04-04)

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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

		Application Number	09/813,592
		Filing Date	March 21, 2001
		First Named Inventor	Daniel J. Lubera
		Art Unit	3677
		Examiner Name	James R. Brittain
Total Number of Pages in This Submission		Attorney Docket Number	
		0275M-000320/CPA	

ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Three copies of Response to Notice of Non-Compliant Appeal Brief with Appendices A-D; return postcard
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Harness, Dickey & Pierce, P.L.C.		Attorney Name Michael D. Zalobsky	Reg. No. 45,512
Signature				
Date	March 7, 2005			

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	Claudia J. Richard	Express Mail Label No.	EV 570 162 794 US
Signature		Date	March 7, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEES TRANSMITTAL
MAR 07 2005 *17*
for FY 2005

Applicant claims small entity status. See 37 CFR 1.27

DEMARK 07/2005

TOTAL AMOUNT OF PAYMENT

(\$ 120)

Complete if Known	
Application Number	09/813,592
Filing Date	March 21, 2001
First Named Inventor	Daniel J. Lubera
Examiner Name	Ruth C. Rodriguez
Art Unit	3677
Attorney Docket No.	0275M-000320/CPA

METHOD OF PAYMENT (check all that apply)

Check Credit Card Money Order None Other (please identify) : _____

Deposit Account Deposit Account Number: 02-2550 Deposit Account Name: The Black & Decker Corporation

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

Charge fee(s) indicated below Charge fee(s) indicated below, except for the filing fee

Charge any additional fee(s) or underpayments of fee(s) Credit any overpayments

Under 37 CFR 1.16 and 1.17

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		
	Small Entity	Fee (\$)	Small Entity	Fee (\$)	Small Entity	Fee (\$)	Fees Paid (\$)
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES

Fee Description

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Small Entity
_____	-20 or HP= 0	x _____	= 0	Fee (\$)

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims
_____	- 3 or HP= 0	x _____	= 0	Fee (\$)

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____	= 0	/ 50 = 0 (round up to a whole number)	x	= 0

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge) : Extension for response within first month (#1251)

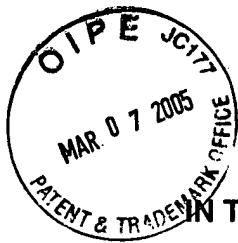
120

SUBMITTED BY

Signature		Registration No. (Attorney/Agent)	45,512	Telephone	248-641-1600
Name (Print/Type)	Michael D. Zalobsky			Date	March 7, 2005

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/813,592
Filing Date: 03/21/2001
Applicant: Daniel J. Lubera et al.
Group Art Unit: 3677
Examiner: Ruth C. Rodriguez
Title: RESILIENT CLIP FASTENER
Attorney Docket: 0275M-000320/CPA

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR ONE MONTH EXTENSION OF TIME AND
RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF**

Sir:

This is an appeal brief in support of an appeal from the June 2, 2004 final rejection of Claims 101 through 111.

Applicant hereby petitions under the provisions of 37 C.F.R. § 1.136(a) for an extension of time in which to respond to the Notice of Non-Compliant Appeal Brief, and includes a fee as set forth in 37 C.F.R. § 1.17(a) with this response for such extension of time.

03/10/2005 YPOLITE1 00000029 022550 09813592

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REAL PARTY IN INTEREST

Emhart Inc., being the assignee of the present application, is the real party in interest.

RELATED APPEALS & INTERFERENCES

To the best of Appellant's knowledge, no other appeals or interferences are pending which will directly affect or be directly affected by or have a bearing on the Board's decision in the present pending appeal.

STATUS OF THE CLAIMS

On September 2, 2004, Appellant appealed from the final rejection of Claims 101 through 111. Claims 9 through 14, 18, 19, 22, and 68 through 94 have been allowed. Claims 1 through 8, 15 through 17, 20 through 21, 23 through 67 and 95 through 100 have been canceled. Claims 112 and 113 have been objected to as being dependent upon a rejected base claim but would be allowable if rewritten in an independent form that includes all of the limitations of the base claim and any intervening claims.

A copy of the claims at issue is provided in attached Appendix A.

A copy of the Office Action mailed June 2, 2004 placing the present application under final rejection is provided in attached Appendix B.

A copy of U.S. Patent No. 5,759,004 to Kuffel is provided in attached Appendix C.

A copy of U.S. Patent No. 5,251,467 to Anderson is provided in attached Appendix D.

STATUS OF AMENDMENTS

No amendment to the claims has been filed or is pending subsequent to the entry of the final rejection.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The invention relates to a clip (10, page 7, line 18, Fig. 2) that includes a flange portion (62, page 10, line 2, Fig. 2), an insertion portion (80, page 10, line 14, Fig. 5) and a retaining portion (82, page 10, line 14, Fig. 5). The insertion portion (80) is coupled to the flange portion (62) and configured to be inserted into a hole (e.g., 316, page 16, line 18, Fig. 15) formed into a first member (e.g., 308, page 16, lines 16-17, Fig. 15), the insertion portion (80) having two portions (92, page 10, line 17, Fig. 6) that are disposed on opposite sides of a longitudinal axis (42, page 8, line 7, Fig. 6) of the resilient clip (10), each of the portions (92) of the insertion portion (80) defining an outer planar surface that is angled upwardly toward the flange portion (62) and outwardly away from the longitudinal axis (42) (see Fig. 6). The retaining portion (82) is coupled to the insertion portion (80) (see Fig. 6) and includes at least one wing member (100, page 11, line 1, Fig. 6) for each of the portions (92) of the insertion portion (80). Each wing member (100) has a warped planar outer surface (e.g., page 11, line 19 through page 12, line 4, Figs. 5, 6 and 8, but see also wing members 500a & 500b in Fig. 18) that coextends with the outer planar surface of an associated one of the portions (92) of the insertion portion (80) (see Fig. 5). The warped planar outer surface is disposed on a same side of the longitudinal axis (42) as the outer planar surface of the associated one of the portions (92) of the insertion portion (80) (see Fig. 6). Each wing member (100) terminates at a tip portion (110, page 11, line 19, Fig. 5) and each of the tip portions (110) are

configured to co-engage the first member (308) (see page 14, lines 17 through 20, Fig. 14).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellants present the following issues for review:

Whether or not Claims 101-103, 105, and 107-110 are unpatentable under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,759,004 to Kuffel.

Whether or not Claims 104 and 111 are unpatentable under 35 U.S.C. §103(a) as being obvious by U.S. Patent No. 5,759,004 to Kuffel.

Whether or not Claim 106 is unpatentable under 35 U.S.C. §103(a) in view of U.S. Patent No. 5,759,004 to Kuffel and U.S. Patent No. 5,251,467 to Anderson.

ARGUMENTS

Rejections Under 35 U.S.C. §102(b)

- Claim 101

Appellant initially notes that the Examiner has stated that each of the legs (18) of the Kuffel cable tie mount define a retaining portion with at least one wing member (i.e., the portion of each leg 18 under an end surface 20) and that each of these wing members has a warped planar outer surface that coextends with the outer planar surface of an insertion portion.

Appellant respectfully submits that the Examiner's assessment of the Kuffel cable tie mount is incorrect as the Kuffel cable tie mount does not include wing members "having a warped planar outer surface that coextends with the outer planar surface of an associated one of the portions of the insertion portion". Applicant notes, too, that the term "warped" means twisted.

Appellant notes that the legs (18) of the Kuffel cable tie mount (10) are configured such that their opposite lateral sides are inwardly offset. In this regard, the entire portion of the leg (18) below each end surface (20) is coplanar and bent inwardly. Accordingly, the portion of the Kuffel cable tie mount (10) that the Examiner has characterized as being a “wing” (i.e., the portion of each leg 18 under an end surface 20) is not warped but rather simply co-planar with a remaining portion of the leg (18).

It is well settled that “the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office.” *In re Skinner*, 2 USPQ 2d 1788, 1788-89 (B.P.A.I. 1986). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992).

In *W.L. Gore & Associates v. Garlock, Inc.*, the Federal Circuit stated that “anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). It is not enough, however, that the reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention “arranged as in the claim”. *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984).

In view of the above, Applicant respectfully submits that the Examiner has not presented a *prima facie* case of anticipation. In this regard, the ‘004 patent to Kuffel does not teach or suggest each and every limitation of Claim 101. Accordingly, ‘004 patent to Kuffel is not “a single prior art reference that discloses each element of the

claim under consideration" and as such, the Examiner's rejection of Claim 101 under 35 U.S.C. §102(b) cannot stand.

Appellant notes that Claims 102, 103, 105, and 107 through 110 depend from Claim 101 and as such, should be in condition for allowance for the reasons set forth for Claim 101, above.

- Claims 102 and 103

Appellant notes that Claim 102 specifies that "each of the tip portions [of the wing members] is angled such that a lateral end of a first one of the wing members extends above a corresponding lateral end of a second one of the wing members that is disposed on an opposite side of the longitudinal axis". The Examiner has stated that this condition is illustrated in Figure 4 of the Kuffel reference. Appellant notes, however, that Figures 4 and 7 illustrate the portion of the Kuffel cable tie mount (10) that the Examiner has characterized as being a "wing" (i.e., the portion of each leg 18 under an end surface 20) as terminating in a common plane that is generally perpendicular to an insertion axis.

In view of the above, Applicant respectfully submits that the Examiner has not presented a *prima facie* case of anticipation or obviousness. In this regard, the '004 patent to Kuffel does not teach or suggest each and every limitation of Claims 102 or 103. Accordingly, '004 patent to Kuffel is not "a single prior art reference that discloses each element of the claim under consideration" and as such, the Examiner's rejection of Claim 102 under 35 U.S.C. §102(b) cannot stand.

Appellant notes that Claim 103 depends from Claim 102 and should be in condition for allowance for the reasons set forth for Claim 102, above.

- Claims 107 and 108

Appellant notes that Claim 107 specifies that each wing member includes a base that is fixedly coupled to the insertion portion and that each wing member is twisted from the base portion to the tip portion through an angle of about 5° to about 45°. Claim 108, which depends from Claim 107, specifies that the angle is about 30°. As noted above in the discussion of Claim 101, the portion of the Kuffel cable tie mount (10) that the Examiner has characterized as being a “wing” (i.e., the portion of each leg 18 under an end surface 20) is not twisted through any angle relative to an adjoining portion of the leg (18) but rather is simply co-planar with an inwardly offset portion of the leg (18).

In view of the above, Applicant respectfully submits that the Examiner has not presented a *prima facie* case of anticipation. In this regard, the '004 patent to Kuffel does not teach or suggest each and every limitation of Claims 107 or 108. Accordingly, '004 patent to Kuffel is not “a single prior art reference that discloses each element of the claim under consideration” and as such, the Examiner’s rejection of Claims 107 and 108 under 35 U.S.C. §102(b) cannot stand.

Rejections Under 35 U.S.C. §103(a) Based on Kuffel

Initially, Appellant notes that Claims 104 and 111 depend from Claim 101 and as such, should be in condition for allowance for the reasons set forth above in Appellant’s arguments for allowance of Claim 101. In brief, the establishment of a *prima facie* case of obviousness requires that three basic criteria be met: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, 2) that there must be a reasonable expectation of

success, and 3) that the prior art reference or references must teach or suggest all the claim limitations. *See, e.g., In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Accordingly, Appellant respectfully submits that the Examiner could not have presented a *prima facie* case of obviousness for Claims 104 or 111 since the Kuffel reference does not teach or suggest each and every limitation of Claim 101. As such, Appellant submits that the Examiner's rejection of Claims 104 and 111 under 35 U.S.C. §103(a) cannot stand. Additional bases for the allowance of Claim 104 is provided below.

- Claim 104

Appellant notes that Claim 104 depends from Claim 102. As noted above in the remarks that specifically pertain to Claims 102 and 103, Claim 102 specifies that "each of the tip portions [of the wing members] is angled such that a lateral end of a first one of the wing members extends above a corresponding lateral end of a second one of the wing members that is disposed on an opposite side of the longitudinal axis". The Examiner has stated that this condition is illustrated in Figure 4 of the Kuffel reference. Appellant notes, however, that Figures 4 and 7 illustrate the portion of the Kuffel cable tie mount (10) that the Examiner has characterized as being a "wing" (i.e., the portion of each leg 18 under an end surface 20) as terminating in a common plane that is generally perpendicular to an insertion axis.

In view of the above, Applicant respectfully submits that the Examiner has not presented a *prima facie* case of obviousness. In this regard, Appellant respectfully submits that the Examiner could not have presented a *prima facie* case of obviousness for Claim 104 since the Kuffel reference does not teach or suggest each and every limitation of Claim 102. As such, Appellant submits that the Examiner's rejection of Claim 104 under 35 U.S.C. §103(a) cannot stand.

Rejections Under 35 U.S.C. §103(a) Based on Kuffel and Anderson

Appellant refers the Board to the section entitled “Rejections Under 35 U.S.C. §102(b)” for a discussion of the Kuffel reference.

Appellant next notes that the Anderson reference is directed to a locking mechanism that may be installed to the front of a cabinet. The mechanism includes a retaining spring (21) with legs (25) that are forced into a hole in the front of the cabinet. The legs (25) spring outwardly and engage the edges of the hole to thereby fixedly secure the lock mechanism in place.

In view of the above, Appellant respectfully submits that the Office has not presented a *prima facie* case of obviousness. The establishment of a *prima facie* case of obviousness requires some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. *See, e.g., In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Moreover, the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on an applicant’s disclosure. *Id.*

Appellant also notes that the Patent Laws draw a distinction between trade-offs and motivation to combine: trade-offs often concern what is feasible, not what is necessarily desirable, whereas motivation to combine requires the latter. *See, e.g., Winner International Royalty Corp. v. Wang*, 2002 F.3d 1340, 53 USPQ2d 1580 (Fed. Cir.), *cert. denied*, 530 U.S. 1238 (2000).

In the instant case, the Examiner argues that “it would have been obvious to one having ordinary skill in the art at the time of applicant’s invention to use a plurality of teeth in the edge of the wing members as shown by Anderson in the

resilient clip disclosed by Kuffel." Appellant notes, however, that the Kuffel cable tie mount does not seek to engage the edges of the hole but rather the bottom surface of the plate into which the mount is inserted. Consequently, it appears that the motivation for the modification is impermissibly found in Appellant's disclosure as the addition of teeth to the ends of the legs of the Kuffel reference would appear to serve no useful purpose. Consequently, the Examiner's rejection of Claim 106 under 35 U.S.C. §103(a) cannot stand.

CONCLUSION

Appellant respectfully submits that the Examiner has not presented a *prima facie* case of anticipation or obviousness. Accordingly, reversal of the final rejection of Claims 101 through 111 is respectfully requested.

Respectfully submitted,



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Date: March 7, 2005

MDZ/cr

Appendix A: Claims At Issue

1 through 8. (Cancelled)

9. (Previously Presented) A resilient clip for use in securing a first member to a second member, the resilient clip comprising:

a flange portion having an aperture, the aperture adapted to receive a threaded fastener to couple the second member to the flange portion;

an insertion portion configured to be inserted into a hole formed into the first member, the insertion portion being coupled to the flange portion; and

a retaining portion coupled to the insertion portion and having first and second wing members, the first wing member being twisted about a first axis in a first direction, the second wing member being twisted about a second axis in the first direction, each of the first and second wing members terminating at a tip portion the tip portion of the first wing member and the tip portion of the second wing member being configured to co-engage the first member;

wherein each of the first and second axes are generally parallel a longitudinal axis of the retaining portion; and

wherein the retaining portion includes first and second abutting flanges having a base that is spaced vertically apart from the first and second wing members, respectively, each of the bases of the first and second abutting flanges being configured to abut a surface of the first member opposite a surface into which the first and second wing members, respectively, are engaged.

10. (Original) The resilient clip of Claim 9, wherein the bases of the first and second abutting flanges are spaced apart from the flange portion.

Appendix A: Claims At Issue

11. (Original) The resilient clip of Claim 9, wherein the bases of the first and second abutting flanges and the flange portion are disposed within a common plane.

12. (Previously Presented) A resilient clip for use in securing a first member to a second member, the resilient clip comprising:

a flange portion having an aperture, the aperture adapted to receive a threaded fastener to couple the second member to the flange portion;

an insertion portion configured to be inserted into a hole formed into the first member, the insertion portion being coupled to the flange portion; and

a retaining portion coupled to the insertion portion and having first and second wing members, the first wing member being twisted about a first axis in a first direction, the second wing member being twisted about a second axis in the first direction, each of the first and second wing members terminating at a tip portion the tip portion of the first wing member and the tip portion of the second wing member being configured to co-engage the first member;

wherein each of the first and second axes are generally parallel a longitudinal axis of the retaining portion; and

wherein the insertion portion is defined by a pair of flanges that are spaced apart about a central axis of the resilient clip, each of the flanges having a first portion, a second portion and a third portion, the first portion being coupled to the flange portion and tapering inwardly toward the central axis and downwardly from the flange portion, the second portion being coupled to an end of the first portion opposite the flange portion and extending downwardly therefrom generally parallel the central axis, the third portion being coupled to an end of the second portion

Appendix A: Claims At Issue

opposite the first portion and tapering outwardly away from the central axis and upwardly toward the flange portion.

13. (Original) The resilient clip of Claim 12, wherein each of the flanges further includes a fastener aperture formed into the first, second and third portions, the fastener aperture being configured to provide clearance for the fastener.

14. (Original) The resilient clip of Claim 12, the insertion portion has a pair of tapered sides that taper downwardly and inwardly toward the central axis.

15. through 17. (Cancelled)

18. (Previously Presented) A resilient clip for use in securing a first member to a second member, the resilient clip comprising:

a flange portion having an aperture, the aperture adapted to receive a threaded fastener to couple the second member to the flange portion;

an insertion portion configured to be inserted into a hole formed into the first member, the insertion portion being coupled to the flange portion;

a retaining portion coupled to the insertion portion and having first and second wing members, the first wing member being twisted about a first axis in a first direction, the second wing member being twisted about a second axis in the first direction, each of the first and second wing members terminating at a tip portion the tip portion of the first wing member and the tip portion of the second wing member being configured to co-engage the first member;

Appendix A: Claims At Issue

a spacing structure having first and second flange members, the first flange member being coupled to the flange portion, the second flange member being coupled to an outer edge of the first flange member and tapering downwardly toward the retaining portion and outwardly from the flange portion;

wherein each of the first and second axes are generally parallel a longitudinal axis of the retaining portion; and

wherein the spacing structure further includes a coupling member that engages and fixedly couples the flange portion to the spacing structure.

19. (Original) The resilient clip of Claim 18, wherein the coupling member includes at least one weld protrusion, the weld protrusion extending through a protrusion aperture formed in the flange portion and thereafter being deformed to inhibit the withdrawal of the weld protrusion from the protrusion aperture.

20. & 21. (Cancelled)

22. (Previously Presented) A resilient clip for use in securing a first member to a second member, the resilient clip comprising:

a flange portion having an aperture, the aperture adapted to receive a threaded fastener to couple the second member to the flange portion;

an insertion portion configured to be inserted into a hole formed into the first member, the insertion portion being coupled to the flange portion;

a retaining portion coupled to the insertion portion and having first and second wing members, the first wing member being twisted about a first axis in a first direction, the second wing member being twisted about a second axis in the first direction, each

Appendix A: Claims At Issue

of the first and second wing members terminating at a tip portion the tip portion of the first wing member and the tip portion of the second wing member being configured to co-engage the first member;

a spacing structure having first and second flange members, the first flange member being coupled to the flange portion, the second flange member being coupled to an outer edge of the first flange member and tapering downwardly toward the retaining portion and outwardly from the flange portion;

wherein each of the first and second axes are generally parallel a longitudinal axis of the retaining portion; and

wherein the first flange member includes a recessed cavity sized to receive and locate the flange portion.

23. through 67. (Canceled)

68. (Previously Presented) The resilient clip of Claim 9, wherein each of the tip portions is angled such that a portion of an associated one of the first and second wing members nearest a centerline of the aperture in the flange portion is longer than a portion of the associated one of the first and second wing members farthest from the centerline of the aperture in the flange portion.

69. (Previously Presented) The resilient clip of Claim 68, wherein the tip portion is defined by an included angle of about 30° to about 80°.

70. (Previously Presented) The resilient clip of Claim 69, wherein the included angle of the tip portion is about 60°.

Appendix A: Claims At Issue

71. (Previously Presented) The resilient clip of Claim 68, wherein the tip portion has a flat edge for contacting the first member.

72. (Previously Presented) The resilient clip of Claim 68, wherein the tip portion has an edge for contacting the first member into which a plurality of teeth are formed.

73. (Previously Presented) The resilient clip of Claim 9, wherein each of the first and second wing members further includes a base portion that is fixedly coupled to the insertion portion, the first and second wing members being twisted such that their tip portions are twisted relative to their base portion by an angle of about 5° to about 45°.

74. (Previously Presented) The resilient clip of Claim 73, wherein the angle is about 30°.

75. (Previously Presented) The resilient clip of Claim 9, further including a spacing structure having first and second flange members, the first flange member being coupled to the flange portion, the second flange member being coupled to an outer edge of the first flange member and tapering downwardly toward the retaining portion and outwardly from the flange portion.

76. (Previously Presented) The resilient clip of Claim 75, wherein the spacing structure is formed from a resilient material.

Appendix A: Claims At Issue

77. (Previously Presented) The resilient clip of Claim 76, wherein the resilient material is plastic.

78. (Previously Presented) The resilient clip of Claim 75, wherein the first flange member is circular in shape.

79. (Previously Presented) The resilient clip of Claim 75, wherein the second flange member extends entirely around a perimeter of the first flange member.

80. (Previously Presented) The resilient clip of Claim 12, wherein each of the tip portions is angled such that a portion of an associated one of the first and second wing members nearest a centerline of the aperture in the flange portion is longer than a portion of the associated one of the first and second wing members farthest from the centerline of the aperture in the flange portion.

81. (Previously Presented) The resilient clip of Claim 80, wherein the tip portion is defined by an included angle of about 30° to about 80°.

82. (Previously Presented) The resilient clip of Claim 81, wherein the included angle of the tip portion is about 60°.

83. (Previously Presented) The resilient clip of Claim 80, wherein the tip portion has a flat edge for contacting the first member.

Appendix A: Claims At Issue

84. (Previously Presented) The resilient clip of Claim 80, wherein the tip portion has an edge for contacting the first member into which a plurality of teeth are formed.

85. (Previously Presented) The resilient clip of Claim 12, wherein each of the first and second wing members further includes a base portion that is fixedly coupled to the insertion portion, the first and second wing members being twisted such that their tip portions are twisted relative to their base portion by an angle of about 5° to about 45°.

86. (Previously Presented) The resilient clip of Claim 85, wherein the angle is about 30°.

87. (Previously Presented) The resilient clip of Claim 12, wherein the retaining portion includes first and second abutting flanges having a base that is spaced vertically apart from the first and second wing members, respectively, each of the bases of the first and second abutting flanges being configured to abut a surface of the first member opposite a surface into which the first and second wing members, respectively, are engaged.

88. (Previously Presented) The resilient clip of Claim 87, wherein the bases of the first and second abutting flanges are spaced apart from the flange portion.

Appendix A: Claims At Issue

89. (Previously Presented) The resilient clip of Claim 87, wherein the bases of the first and second abutting flanges and the flange portion are disposed within a common plane.

90. (Previously Presented) The resilient clip of Claim 12, further including a spacing structure having first and second flange members, the first flange member being coupled to the flange portion, the second flange member being coupled to an outer edge of the first flange member and tapering downwardly toward the retaining portion and outwardly from the flange portion.

91. (Previously Presented) The resilient clip of Claim 90, wherein the spacing structure is formed from a resilient material.

92. (Previously Presented) The resilient clip of Claim 91, wherein the resilient material is plastic.

93. (Previously Presented) The resilient clip of Claim 90, wherein the first flange member is circular in shape.

94. (Previously Presented) The resilient clip of Claim 90, wherein the second flange member extends entirely around a perimeter of the first flange member.

95. through 100. (Canceled)

Appendix A: Claims At Issue

101. (Previously Presented) A resilient clip for use in securing a first member to a second member to a second member, the resilient clip comprising:

a flange portion;
an insertion portion that is coupled to the flange portion and configured to be inserted into a hole formed into the first member, the insertion portion having two portions that are disposed on opposite sides of a longitudinal axis of the resilient clip, each of the portions of the insertion portion defining an outer planar surface that is angled upwardly toward the flange portion and outwardly away from the longitudinal axis; and

a retaining portion coupled to the insertion portion, the retaining portion including at least one wing member for each of the portions of the insertion portion, each wing member having a warped planar outer surface that coextends with the outer planar surface of an associated one of the portions of the insertion portion, the warped planar outer surface being disposed on a same side of the longitudinal axis as the outer planar surface of the associated one of the portions of the insertion portion;

wherein each wing member terminates at a tip portion and each of the tip portions are configured to co-engage the first member.

102. (Previously Presented) The resilient clip of Claim 101, wherein each of the tip portions is angled such that a lateral end of a first one of the wing members extends above a corresponding lateral end of a second one of the wing members that is disposed on an opposite side of the longitudinal axis.

Appendix A: Claims At Issue

103. (Previously Presented) The resilient clip of Claim 102, wherein each tip portion is defined by an included angle of about 30° to about 80°.

104. (Previously Presented) The resilient clip of Claim 103, wherein the included angle of each tip portion is about 60°.

105. (Previously Presented) The resilient clip of Claim 101, wherein each tip portion has a flat edge for contacting the first member.

106. (Previously Presented) The resilient clip of Claim 101, wherein each tip portion has an edge for contacting the first member into which a plurality of teeth are formed.

107. (Previously Presented) The resilient clip of Claim 101, wherein each of the first and second wing members further includes a base portion that is fixedly coupled to the insertion portion, the first and second wing members being twisted such that their tip portions are twisted relative to their base portion by an angle of about 5° to about 45°.

108. (Previously Presented) The resilient clip of Claim 107, wherein the angle is about 30°.

Appendix A: Claims At Issue

109. (Previously Presented) The resilient clip of Claim 101, further including a spacing structure having first and second flange members, the first flange member being coupled to the flange portion, the second flange member being coupled to an outer edge of the first flange member and tapering downwardly toward the retaining portion and outwardly from the flange portion.

110. (Previously Presented) The resilient clip of Claim 109, wherein the spacing structure is formed from a resilient material.

111. (Previously Presented) The resilient clip of Claim 110, wherein the resilient material is plastic.

112. (Previously Presented) The resilient clip of Claim 109, wherein the first flange member is circular in shape.

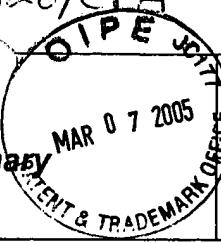
113. (Previously Presented) The resilient clip of Claim 109, wherein the second flange member extends entirely around a perimeter of the first flange member.

024511-000520/US11

Final OA

Due 9-2-01

Office Action Summary



VCMB

D2

Application No.

09/813,592

Applicant(s)

LUBERA ET AL.

Examiner

Ruth C Rodriguez

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 04 March 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 9-14, 18, 19, 22, 68-94 and 101-113 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 9-14, 18, 19, 22 and 68-94 is/are allowed.
 6) Claim(s) 101-111 is/are rejected.
 7) Claim(s) 112 and 113 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 21 March 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).
2. Misnumbered claims 102 (second occurrence)-110 been renumbered 103-111.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 101-103, 105 and 107-110 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuffel (US 5,759,004).

A resilient clip (10) secures a first member (30) to a second member (26,28) (Figs. 1, 9 and 10). The resilient clip comprising a flange portion (lower portion of 14), an inserting portion (18) and a retaining portion (20). The insertion portion is coupled to the flange portion and inserts into a hole (32) formed into the first member (Figs. 1, 9 and 10). The inserting portion has two portions that are disposed on opposite side of a

longitudinal side of a longitudinal axis of the resilient clip (Figs. 1-9). Each of the portion of the insertion portion defines an outer planar surface that is angled upwardly toward the flange portion and outwardly away from the longitudinal axis (Fig. 2, 3, 7, 8 and 10). The retaining portion is coupled to the insertion portion and includes at least one wing member (20) for each of the portions of the insertion portion. Each wing member has a warped planar outer surface that coextends with the outer planar surface of an associated one of the portion of the insertion portion (Figs. 2-4 and 6-10). The warped outer surface is disposed on a same side of the longitudinal axis as the outer planar surface of the associated one of the portions of the insertion portion (Figs. 2-4 and 6-10). Each wing member terminates at a tip portion and each of the tip portions are co-engage the first member (Figs. 1-10).

Kuffel also discloses that:

- Each of the tip portions is angled such that a lateral end of the first one of the wing members extends above a corresponding lateral end of a second one of the wing members that is disposed on an opposite side of the longitudinal axis (Fig. 4).
- The tip portion is defined by an included angle of about 30 degrees to about 80 degrees (Fig. 4).
- Each tip portion has a flat edge for contacting the first member (Figs. 1-10).
- Each of the first and second wing members further include a base portion (16a) that is fixedly coupled to the insertion portion (Figs. 2-5). The first and second wing members being twisted such that the their tip portions are twisted relative to their base portion by an angle of about 5 degrees to about 45 degrees (Figs. 6).

- The angle is about 30 degrees (Fig. 6).
- The resilient clip further includes a spacing structure (16, upper part of 14) having first (upper part of 14) and second (16) flange members (Figs. 1-10). The first flange member is coupled to the flange portion and the second flange member is coupled to an outer edge of the first flange member and tapering downwardly toward the retaining portion and outwardly from the flange portion (Figs. 1-5, 7, 8 and 10).
- The spacing structure is formed from resilient material.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claim 104 and 111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuffel.

Kuffel discloses that the included angle is about 30 degrees. Kuffel fails to disclose that the included angle of the tip portion is about 60 degrees. However, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have the included angle of the tip portion being about 60 degrees. A change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

The resilient clip disclosed by Kuffel is made from sheet metal and therefore the spacing structure will also be made from sheet metal. Kuffel fails to disclose that the spacing structure is made from a resilient material where the resilient material is plastic.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the resilient clip made from plastic such that the spacing structure will also be made from plastic because the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). In this case, the use of plastic is widely known in the art for the resilient clips because this material has a lighter weight and provides protection to the clip due to exposure to the weather.

7. Claims 106 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuffel in view of Anderson (US 5,251,467).

Kuffel discloses a resilient clip having the limitations listed above in paragraph 4 for the rejection of claim 101. Kuffel fails to disclose that the tip portion has an edge for contacting the first member into which a plurality of teeth is formed. However, Anderson teaches a cam lock comprising a pair of wing members (25). The wing members initially are shown have an edge with a flat surface for contacting a structure (5,6) (Figs. 5 and 6). Anderson also teaches that the wing members have an edge with a plurality of teeth (Fig. 7). The teeth will lock the edges of the wing members against the structure and allow for variations in thickness of the structure. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to use a plurality of teeth in the edge of the wing members as shown by Anderson in the resilient clip disclosed by Kuffel. Doing so, will lock the edges of the wing members against the structure and allow for variations in the thickness of the structure.

Allowable Subject Matter

8. Claims 9-14, 18, 19, 22 and 68-94 are allowed.
9. Claims 112 and 113 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 101-111 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wiley (US 2,217781), Poutpitch (US 2,509,192), Meyer (US 2,959,259), Osterland et al. (US 4,630,338), Kuffel (US 5,759,004), Cornell et al. (US 5,774,949) and Danby et al. (US 5,873,690) are cited to show state of the art with respect to resilient clips having some of the features disclosed by the current invention.

Hirohata (US 4,668,145) is cited to show state of the art with respect to a flange extending around the periphery of the main body of a fastener.

Van Order et al. (US 5,636,891) is cited to show state of the art with respect to the use of spacing structures and resilient clips.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (703) 308-1881. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (703) 306-4115.

Submissions of your responses by facsimile transmission are encouraged. Technology center 3600's facsimile number for before and after final communications is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Ruth C. Rodriguez
Patent Examiner
Art Unit 3677

rcr
June 1, 2004



ROBERT J. SANDY
PRIMARY EXAMINER